

Reply to Office Action of June 20, 2007
Appl. No. 10/719,588
Group Art Unit: 1617

Remarks

The following remarks are responsive to the June 20, 2007 Office Action.
Applicants respectfully request reconsideration.

Status of the Claims

Claims 1, 4 and 5 are amended. Claims 6-9 are withdrawn without prejudice in view of the Requirement for Restriction, and may be subject to rejoinder. Claims 10-12 are cancelled. Claims 13-17 are added. Claims 1-5 and 13-17 are pending.

Support for Amendments to the Claims/Added Claims

Support for the amendments to Claim 1 and new Claims 13-17 is found on page 3, lines 17-19 of the specification, in cancelled Claim 12, and in original Claims 1-5. No new matter is added.

Rejections under 35 U.S.C. § 102(b)

Claims 1, 4-5 and 10-12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,344,582 (Umemoto), Publication No. XP-002298686 (Garland), and Great Britain Patent No. 1,303,773 (Monsanto). Claim 1 (from which claims 4-5 depend) is amended to clarify the invention. Claims 10-12 are cancelled, rendering the rejection moot.

Umemoto relates to a traction fluid lubricant. Since Umemoto does not disclose the bicyclohexyl compounds of formula (I) in a cosmetic preparation (Claims 1-5), or in a pharmaceutical composition (new Claims 13-17), the reference fails to anticipate the invention as claimed, and the rejection should be withdrawn.

Garland relates to a 2-methyl-bicyclohexyl compound. Since Garland does not disclose the bicyclohexyl compound of formula (I) in a cosmetic preparation (Claims 1-5), or in a pharmaceutical composition (new Claims 13-17), the reference fails to anticipate the invention as claimed, and the rejection should be withdrawn.

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Monsanto relates to a traction fluid composition. Since Monsanto does not disclose bicyclohexyl compounds of formula (I) in a cosmetic preparation (Claims 1-5), or in a pharmaceutical composition (new Claims 13-17), the reference fails to anticipate the invention as claimed, and the rejection should be withdrawn.

Reconsideration and withdrawal of the rejections are respectfully requested.

Rejections under 35 U.S.C. § 103(a)

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Monsanto (as applied above). The Examiner asserts that Monsanto does not teach the particular compound of formula (III) or formula (IV). Applicants agree.

In addition, Monsanto fails to disclose, teach, or provide a reason to one skilled in the art to include a compound of formula (III) or formula (IV) in a cosmetic preparation (Claim 1) or in a pharmaceutical composition (new Claims 13-15). In addition, one skilled in the art would not have been reasonably expected to include a traction fluid lubricant in a cosmetic preparation or a pharmaceutical composition, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

Supplemental Information Disclosure Statement

A copy of Form PTO-1449 (returned with the Action), did not include the Examiner's initials with regard to WO 98/00077. Upon investigation, the undersigned noted a transposition of the number from WO 89/00077. Accordingly, a Supplemental Information Disclosure Statement is enclosed. The Examiner is requested to consider the WO 89/00077 reference, and initial, date, and return a copy of Form PTO-1449 to the undersigned.

Fees

No fees are believed due. The Commissioner is authorized, however, to charge any fees deemed due (or credit any balance owing) to Deposit Account No. 50-1177.

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Conclusion

It is respectfully submitted that Claims 1-5 and 13-17 are in condition for allowance. A Notice of Allowance is respectfully requested. The Examiner is invited to contact Applicants' attorney at the telephone number indicated below if anything further is needed to advance the allowance thereof.

Respectfully submitted,

September 13, 2007

Date


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